



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,223	01/21/2000	Lori L. Carrigan	P04353US0	5582

27142 7590 06/30/2003

MCKEE, VOORHEES & SEASE, P.L.C.
ATTN: PIONEER HI-BRED
801 GRAND AVENUE, SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/489,223

Applicant(s)

CARRIGAN, LORI L.

Examiner

Ashwin Mehta

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☒ Newly proposed or amended claim(s) 5,33 and 41 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-7 and 20.

Claim(s) objected to: _____.

Claim(s) rejected: 8-19 and 21-42.

Claim(s) withdrawn from consideration: _____.

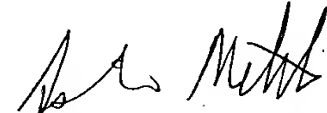
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The recitation "stably integrated" in claims 8, 12, 21, 25, and the new claims is new matter. The specification does not recite or contain a description of this recitation. Claims 8, 21, 46, 48, and 49 are indefinite. In claims 8 and 21, it is not clear what is meant by "stably integrated male sterility." In claims 48 and 49, it is not clear what is meant by "stably integrating male fertility." New claims 48 and 49 do not meet the requirements of 35 U.S.C. 101, as the claimed method does not have a substantial utility. The plant produced by the claimed method would have a transgene conferring male fertility restoration. However, hybrid 38A24 is not male sterile, and therefore does not need to have its male fertility restored.

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 11, 15, 19, 24, 28, 32, 34, 38-42 under 35 U.S.C. 112, 2nd paragraph; the rejection of claim 33 under 35 U.S.C. 112, 1st paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: the amended and newly proposed claims introduce new matter and raise utility issues, as indicated above.

Continuation of 10. Other: the amendment to page 46 of the specification, amending the deposit information to include information concerning the deposit of seed of the inbred parents of hybrid 38A24, has been entered.


ASHWIN D. MEHTA, PH.D.
PATENT EXAMINER